REMARKS

Claims 1 through 14 have been examined. Applicants again gratefully acknowledge the indication of allowable subject matter with regard to Claims 12-14. Applicants also note that the Examiner has rejected Claims 1-11 and 15-20. In light of the arguments below, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

More specifically, three criteria must be considered in order for an Examiner to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.). **Applicants respectfully submit that the instant rejection fails on both the first and third criteria.**

For the USPTO to combine references in an obviousness analysis, the USPTO must do two things. First, the USPTO must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999). While the

range of sources for the motivation is broad, the range of available sources does not diminish the requirement for actual evidence. *Id.*

Four independent claims exist in the present application as Claims 1, 4, 10, and 12. Claim 12 has been allowed. Claim 1 has been rejected on the basis of the combination of Kim et al. (US Pat. No. 6,456,850) in view of Zdunek et al. (US Pat. No. 4,870,408). Claims 4 and 10 have been rejected on the basis of the combination of Kotzin et al. (US Pat. No. 5,796,722) in view of Zdunek et al. (US Pat. No. 4,870,408). Applicants acknowledge, with traverse, the further rejections of dependent Claims 2-3, 5-9, 11, and 15-20 based on further cited art. For purposes of clarifying the present After Final Response, the rejections of such dependent claims will not be further discussed as such rejections shall be understood to fall with the base rejection of independent Claims 1, 4, and 10.

In the outstanding rejection, the Examiner states in regards to Claim 1 that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to establish the threshold level, reading on the claimed 'maximum load value,' as that of the data activity, reading on the claimed 'data load value,' as taught by Zdunek et al., in the method of Kim et al., in order to balance call load efficiently."

In the outstanding rejection, the Examiner further states in regards to Claim 4 that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allocate data channels which may also carry voice traffic for voice traffic only as taught by Zdunek et al., in the system of Kotzin et al., in order to balance call traffic efficiently."

In the outstanding rejection, the Examiner still further states in regards to Claim 10 that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allocate data channels which may also carry voice traffic for

voice traffic only as taught by Zdunek et al., in the apparatus of Kotzin et al., in order to balance call traffic efficiently."

Applicants respectfully submit that, in general, balancing connotes some reconciliation or correspondence between two things. In the present context, the load balancing according to the present invention is a balancing between voice traffic and data traffic. No such balancing is shown or fairly suggested in the base reference to Kim et al. Indeed, a global text search of Kim et al. fails to yield any existence of the term "balance" in any form. Rather than balancing, Kim et al. details a method for preventing an overload condition in a communications system. This is accomplished by establishing a threshold on a call load and blocking admission once the threshold is met. Unlike the present invention, no distinction is made between voice and data loads in Kim et al.

In Kim et al., no attempt is made to balance voice and data loads relative to one another. Kim et al. therefore does not balance loads, but rather merely treats an aggregate load of voice and /or data calls against a threshold. No load balancing exists or is needed in Kim et al. As no load balancing is needed in Kim et al., no conversion (as is claimed in Applicants' claims 1, 4, and 10) from voice and data traffic to voice-only traffic would ever be required.

Further, as no load balancing is needed in Kim et al., adding load balancing aspects of any of the other cited references would not form any benefit. Indeed, there is no suggestion or motivation whatsoever to add load balancing between voice and data loads in Kim et al. because no distinction is made between the voice and data loads in Kim et al. Moreover, adding load balancing to Kim et al. even if, *arguendo*, the reference to Zdunek et al. shows such aspects, does not change the fact that Kim et al. does not perform load balancing, does not require load balancing, and does not suggest anything but overload prevention. Accordingly, adding load balancing of Zdunek et al. for the purpose of improving load balancing in Kim et al. would be

entirely without support or suggestion as no load balancing in Kim et al. is shown or suggested.

Still further, Applicants respectfully submit that the Examiner is merely loosely equating claimed features of the present invention to portions of the Kim et al., Kotzin et al., and Zdunek et al. references and then suggesting generalized, hindsight rationale to combine that includes a blanket assertion of efficiently balancing call load. Applicants submit that no explicit motivation exists in any of the cited references to make the stated combinations. Moreover, the Examiner renders this assertion based on the subject matter of the present application without providing a motivation from the cited references nor providing any other evidence. The only motivation given by the examiner is of a personal, conclusory nature, such that the cited references should be combined "in order to balance call load/traffic efficiently." Indeed, adding load balancing to improve load balancing is improper motivation and clearly circular logic. This is not a motivation to combine the references, but evidence of the fact that it took inventive effort to reach the claimed invention. Absent such teaching or suggestion in the references, the combination cannot be made.

Applicants respectfully submit that there is no motivation or suggestion to combine these references, apart from forbidden hindsight analysis based on the present application. In order to prevent hindsight analysis, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive to the combination disclosed in the patent at issue. See, e.g., Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343 (Fed. Cir. 2000): "*the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test of obviousness.*", and Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d at 1371-1372 (Fed. Cir. 2000), "*Combining prior art references without evidence or a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability–the essence of hindsight.*"

Accordingly, it is respectfully submitted that the rejection fails to establish a *prima facie* case of obviousness, by failing to provide and support an adequate motivation to combine the cited references to support the rejection.

Still further, even if combined, Applicants believe that the load balancing relied upon in Zdunek et al. differs from Applicants' claimed invention and thus does not provide to either base reference (Kim et al. or Kotzin et al.) the load balancing as claimed by Applicants. Contrary to the Examiner's assertions, the Zdunik et al. reference pertains to a call admission gating function that includes re-allocation of channels to either voice or data when, correspondingly, voice activity or data activity is deemed to be high (see column 8, lines 9-42). More importantly, when load leveling is required due to unbalanced traffic across the channels, Zdunik et al. does not function in the manner claimed by the Applicants. Load balancing in Zdunik et al. is accomplished by redistribution of activity across available channels (see Col. 8, line 55 through Col. 9, line 19), rather than conversion of a channel to voice-only traffic upon exceeding a load threshold that ensures acceptable quality of communications as in Applicants' claimed invention.

In sum, the Applicants respectfully submit that the cited references fail to teach or fairly suggest any motivation to combine the call admission gating function of Zdunek et al. with either of the Kim et al. reference or the Kotzin et al. reference, and that Zdunek et al. further does not provide the same load balancing as claimed by Applicants even if, *arguendo*, the present combination of references were valid.

Applicants submit that as independent Claims 1, 4, and 10 are believed allowable, the further rejections of dependent Claims 2-3, 5-9, 11, and 15-20 based on further cited art should also be overcome.

CONCLUSION

Applicants respectfully submit that Claims 1 through 20 are not shown or fairly suggested by the cited references taken alone or in any combination. Accordingly, the outstanding rejections should be withdrawn.

No additional fee is believed due for this submission. However, Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted deposit account.

It is submitted that this application is now in condition for allowance, and action to that end is respectfully requested.

Respectfully submitted,
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